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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,944	03/05/2002	Christopher L. Parmelee	D-1154R3	5491

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,944

Applicant(s)

PARMELEE ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9 January 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-11 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In independent claim 1, the "enabling..." phrase makes the claim indefinite and unclear in that neither means nor interrelationship of means are set forth in the claim in order to achieve the desired results expressed in the "enabling..." phrase. Additionally, it should be emphasized that the phrase "enabling..." is vague in its nature due to that it does not positively recite the action and the steps that need to be performed by the method and steps, it only implies that such steps could be taken and it does not necessary makes it so. Therefore, the claims are rendered to be indefinite and failing to particularly point out what are the steps that must be performed.

5. Dependent claims 2-11 are unclear in that they depend from unclear independent claims.

6. In claim 9, the phrase "at least some..." renders the claim vague and indefinite in that neither means nor interrelationship of means are set forth in the claim in order to achieve the desired results expressed in the "enabling..." phrase.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. As per independent claim 1 and dependent claims 2-3, the examiner asserts that applicant's element/step "c)" represents nonfunctional descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed. MPEP 2106 IV B 1(b). In analyzing claim language for its limiting effect, the examiner has applied two basic steps: i) review the claim as a whole to see whether or not any descriptive material is being recited; ii) if descriptive material is found, determine how this descriptive material is being used in the claim as a whole, and ultimately conclude whether the data in question alters or reconfigures the system or method steps, or merely means something to the human mind. *Id.* Common limitations where nonfunctional data could be found often include those directed to sending, receiving, storing, and displaying data. *Id.* The element/step "c)" of applicant's claim 1 recites element of a marking and indicia visible to a human for determination of acceptability of the card for providing the service. This "mark" qualifies as descriptive material since it is directed to a visible indicia related to a service provider. With regards to how this descriptive material is being used, applicant's described marking or indicia visible to human is not explicitly recited as being altered or impacted by any other element/step in the claim. Except for the meaning of the data to the human mind, the visual inspection of the indicia to match the mark of the service provider lacks any functional relationship to the other elements/steps as the are recited in the claim and the interrelationship of the elements in the claim as a whole. Thus, such nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,850,442 to Sead Muftic.

11. As per claims 1-3, Muftic clearly teaches a method comprising:

a) producing a plurality of digital certificates for a plurality of individual customers, wherein each individual customer is associated with an account (See Muftic figures 6, 7, 20, and 22 and associated text, column 5, line 36-column 8, line 7, and column 12, lines 5-58, and column 17, line57-column 18, line 10);

b) associating the accounts of the individual customers with the corresponding digital certificates of the individual customers (See Muftic figures 6, 7, 20, and 22 and associated text, column 5, line 36-column 8, line 7, and column 12, lines 5-58, and column 17, line57-column 18, line 10);

c) producing at least one card for each of the individual customers, wherein each card includes a first visible indica thereon which corresponds to a source indicator mark for a digital signature service, wherein each card includes machine readable data corresponding to an account number associated with the account of the individual customer (See Muftic figures 6, 7, 20, and 22 and associated text, column 5, line 36-column 8, line 7, and column 12, lines 5-58, and column 17, line57-column 18, line 10);

d) sending the cards to the individual customers (See Muftic figures 6, 7, 20, and 22 and associated text, column 5, line 36-column 8, line 7, and column 12, lines 5-58, and column 17, line57-column 18, line 10); and

e) enabling each individual customer to digitally sign an electronic document using any one of a plurality of automated transaction machines and one of the cards, wherein each automated transaction machine is operative to display a visual representation of the electronic document through a display

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device of the automated transaction machine, wherein each automated transaction machine is operative to cause the electronic document to be digitally signed through communication with the digital signature service, wherein the communication includes the account number read from the card by the automated transaction machine (See Muftic figures 6, 7, 20, and 22 and associated text, column 5, line 36-column 8, line 7, and column 12, lines 5-58, and column 17, line 57-column 18, line 10).

However it is not clear in Muftic if there are any marking visible to the user at the terminal performing the transaction. It would have been obvious to one having ordinary skill in the art at the time the current invention was made to place indicia indicating markings of the entity providing service to the user to make sure that the user is communicating with the appropriate certifying authority providing the services. For example, ATM's bearing multiple markings for Visa, Master Card, Amex, or other intercommunity service providers in the financial area such as Plus or Cirrus, which most ATM machine bear their marking to advise the user that their financial card such as credit cards or bank transaction cards are serviceable at that ATM point of transaction. Sometime, when a user visits a web site and wants to conduct a purchase or any other transactions online such markings are provided to inform the user that they may use their credit cards such as MasterCard or Visa, charge cards such as American Express or Diners Club, or just their Bank cards (transaction token). It is customary in the art to advise the users of what type of credit card or charge cards are acceptable by the system such as an ATM or online purchase, to provide the user with more flexibility and choice.

As per claim 4, Muftic clearly teaches the method according to claim 1, further Muftic teaches in step (a) each digital certificate includes a public key that corresponds to a private key, wherein in step (c) the digital signature service is operative to cause the electronic document to be digitally signed responsive to the private key that corresponds to the public key of the digital certificate which is associated with the account of the individual customer using the machine (See Muftic column 1, lines 33-67, column 3, lines 38-42, and column 7, lines 46-63).

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As per claim 5 Muftic clearly teaches the method according to claim 1, further Muftic teaches in step (e) the digital signature service is operative to access a private key associated with the account number read from the card, wherein the digital signature service is operative cause the electronic document to be digitally signed responsive to the private key (See Muftic column 1, lines 33-67, column 3, lines 38-42, and column 7, lines 46-63).

As per claims 6 and 10, Muftic clearly teaches the method according to claim 1, further Muftic teaches in step (c) the cards correspond to financial account cards, wherein the accounts correspond to financial accounts (See Muftic column 20, line 57- column 21, line 7). In addition, it would have been It would have been obvious to one having ordinary skill in the art at the time the current invention was made to interconnect the financial account information of a user to associate with certification authority of the public/private key management system of they might even be the same for the reason that it make it more controllable and as well as it would be beneficial to only use one card or smart token to conduct multiple transaction rather than having multiple cards associated with multiple entities for conducting secure transaction. For example as it is thought by U.S. Application Publication No. 2002/0004783 to Cris T. Paltenche et al.

As per claim 7, Muftic clearly teaches the method according to claim 6, further Muftic teaches in step (e) the automated transaction machines are operative to cause processing fees to be assessed for the digital signing of electronic documents, and further comprising: f) enabling an entity that manages the financial accounts for the individual customers to receive at least a portion of the processing fees (See Muftic column 14, lines 3-19). However, it is also an essential part of financial transactions to charge fees for conduction such transaction. For example it is well known in the art that if one is using an ATM that does not belong to their own network such as a bank ATM network the out side network let say the card was issued by SunTrust bank and the user uses the Bank of America ATM, there is a fee that is charged by the user's bank SunTrust and another fee by the Bank of America which is paid by the SunTrust bank to

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Bank of America on behalf of the user for using the Bank of America network. Therefore, it is an obvious to have added such fee structure to the current Muftic's system and method.

As per claim 8, Muftic clearly teaches the method according to claim 1, further Muftic is not specific and clear on the step (e) the automated transaction machines include digitizing signature pads, wherein the automated transaction machines are operative to include handwritten signature data captured with the digitizing signature pads in the electronic documents. However, it is well known in the art of utilizing such devices for capturing actual hand written signatures as well as other digitized information at the point of sale or transaction for further assurance of evidentiary of the users identification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to enhance the identification of the user at the point of sale or transaction as well as keeping records of actual human entered evidence of presence for archiving and identification.

As per claim 9, Muftic clearly teaches the method according to claim 1, further Muftic teaches at least some of the automated transaction machines include cash dispensers, wherein the automated transaction machines that include cash dispensers are further operative to dispense cash (See Muftic column 4, lines 48-59).

As per claim 11, Muftic clearly teaches the method according to claim 1, further Muftic teaches in step (a) the accounts correspond to digital safe deposit accounts, wherein in step (c) the cards correspond to digital safe deposit account cards (See Muftic column 9, lines 34-38, column 12, lines 53-58, and column 19, lines 1-21). It would be also obvious to one skill in the art that secure repositories at a remote server as it is known in the art as secure server repositories can be used for storing information or documents such as in secure vaults. Therefore, it would have beneficial to have added to the system of Muftic as an additional convenience to users to have all their important documents in a single secure repository online such as services provided by online service like Yahoo, Hotmail, or ISPs.

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Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

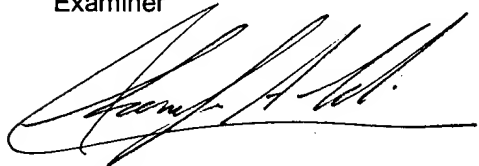
(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.

July 24, 2005